



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,954	07/27/2000	Frederick W. Ryan JR.	F-173	9430

7590 09/20/2002

Pitney Bowes Inc
Intellectual Property and
Technology Law Department
35 Waterview Drive P.O. Box 3000
Shelton, CT 06484

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,954

Applicant(s)

RYAN, FREDERICK W.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1) The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2) Figure 2B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3) The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "420" in Fig.1.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 3629

Specification

- 4) The disclosure is objected to because of the following informalities:

On Page 4, line 25; and Page 5, line 1, respectively, "replay" should be changed to --reply--.

On Page 11, lines 3, 7 and 32; and Page 12, numerous occasions, respectively, "28" should be changed to --26--.

Appropriate correction is required.

Claim Objections

- 5) Claims 1-3, 5 and 19 are objected to because of the following informalities:

In Claim 1, line 6; and Claim 19, line 3, respectively, "replay" should be changed to --reply--.

In Claim 5, line 3, "a hygiened addressed" should be changed to --the hygiened address--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 6) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 7) Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The method of printing a postage indicium for use with a business reply mail piece renders the claim indefinite because it is not clear whether the senders or business owners print the postage indicium, or the consumers must print the postage indicium for use with the business reply mail piece. If the consumer must print the postage indicium for the business reply mail piece, this method is deemed to be against the general public policy because the consumers should bear the burden of buying the necessary postage metering machine to print the postage indicium. Although the consumers would get the subsidy from the senders later, the consumers should not be forced to initially purchase the postage metering machine so as to simply reply the business reply mail.

In Claim 2, lines 2-3, the recitation of "the delivery address" lacks antecedent basis.

In Claim 4, line 8, the recitation of "the postage metering system" lacks antecedent basis.

Claim Rejections - 35 USC § 102

8) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9) Claims 1-2 and 19, as far as Claims 1-2 are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer (US 6,282,524).

Kramer discloses a method of operating a postage metering system for printing a postage indicium, comprising the steps of:

transmitting a registration ID number to a data center, the registration ID number being associated a particular mail campaign of which the business reply mail piece is a part (see Figs.);

receiving postage indicium information from the data center (via modem (18));

printing the postage indicium on the business reply mail piece using the information (see Figs.); and

including within the postage indicium information relating to a delivery address.

10) Claims 1-2, 4, 9, 15 and 19, as far as claims 1-2, 4, and 9 are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Stier et al. (US 6,428,219).

Stier et al. discloses a method of operating a data center (128) for generating postage indicium information for use with printing a postage indicium on a business reply mail piece, the method comprising the steps of:

receiving a delivery address from a sender (130);

generating a registration ID number corresponding to the delivery address;
establishing a transaction session with a postage metering system (120);
receiving the registration ID number from the postage metering system;
generating the postage indicium information using the registration ID number;
transmitting the postage indicium information to the postage metering system;
and
printing the registration ID number on the business reply mail piece (see Figs.).

Stier et al. further discloses a memory device accessible by a computer system, which enables the method Claims as recited above.

11) Claims 1-4, 8-9, 14-19, as far as claims 1-4, 8-9 and 14 are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Allott, III (US 6,121,565).

Allott discloses a method of operating a data center for generating postage indicium information for use with printing a postage indicium on a business reply mail piece, the method comprising the steps of:

receiving a delivery address from a sender;
generating a registration ID number corresponding to the delivery address;
establishing a transaction session with a postage metering system;
receiving the registration ID number from the postage metering system;
generating the postage indicium information using the registration ID number;
transmitting the postage indicium information to the postage metering system;

Art Unit: 3629

providing a subsidy for mailing the business reply mail piece when the business reply mail piece is posted within a specified time period (see Figs.);

receiving an expiration date from the sender of the mail campaign (see Figs.);

providing a warning to for attempting to reply after the expiration date; and

printing the registration ID number on the business reply mail piece.

Allott further discloses a memory device accessible by a computer system, which enables the method Claims as recited earlier.

12) Claim 19 is rejected under 35 U.S.C. 102 either (b) or (e) as being anticipated by Whitehouse (US 5,319,562), Williams (US 5,324,927), Pierce et al. (US 5,988,897), Kara (US 6,208,980), Fougere et al. (US 4,743,747), Rotermund (US 5,520,990), Tighe (US 5,207,373), or Michlin (US 5,642,855).

All the above cited references disclose a business reply mail piece, comprising:
a registration ID number associated with a delivery address and a particular mail campaign of which the business reply mail piece is a part (see generally Figs.).

Claim Rejections - 35 USC § 103

13) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3629

14) Claims 5 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stier et al. in view of Kramer.

Stier et al. discloses the invention as recited earlier, but does not expressively disclose the limitations of Claims 5 and 10-11.

Kramer teaches, for the method of operating a postage metering system for printing a postage indicium, that the method includes the step of performing address hygiene on the delivery address and transmitting a hygiene address to the sender.

Since Kramer and Stier et al. are both from the same field of endeavor, the purpose disclosed by Kramer would have been well recognized in the pertinent art of Stier et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to perform address hygiene on the delivery address of Stier et al., as taught by Kramer, for the purpose of ensuring more accurate delivery and qualifying the postage for automation discounts offered by the postal service and making available to the indicia's linking control methods.

15) Claims 5-7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allott, III in view of Kramer.

Allott discloses the invention as recited earlier, but does not expressively disclose the limitations of Claims 5 and 10-11.

Kramer teaches, for the method of operating a postage metering system for printing a postage indicium, that the method includes the step of performing address hygiene on the delivery address and transmitting a hygiene address to the sender.

Since Kramer and Allott are both from the same field of endeavor, the purpose disclosed by Kramer would have been well recognized in the pertinent art of Allott.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to perform address hygiene on the delivery address of Allott, as taught by Kramer, for the purpose of ensuring more accurate delivery and qualifying the postage for automation discounts offered by the postal service and making available to the indicia's linking control methods.

Conclusion

16) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,009,417 is cited to show a proof-of-postage generating system wherein funds application of those funds, the replenishment of those funds and the auditing of those funds are secure against attempts at fraud.

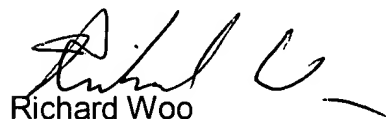
US 6,085,126 is cited to show a system and method for preparing custom designs for multiple types of imprintable media. The system includes one or more first computers coupled to the second computer. Custom designs and orders are automatically transmitted to the second computer for order processing.

US 5,801,944 is cited to show a system and method for printing postage indicia directly on documents or onto a label. A processor based system is programmed to interact with a customer to produce individualized documents, printed address labels, and a printed postage meter stamp having in one embodiment, a customized postage indicia.

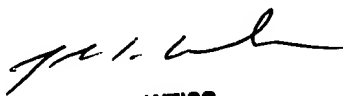
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
September 16, 2002



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600